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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of

Akira SUGIYAMA

Art Unit: 3621

Serial No. 09/194,051

Examiner: C. Hewitt

Filed: March 25, 1999

For: UNIQUE TIME GENERATING DEVICE AND AUTHENTICATING

REPLY BRIEF

BOX AF

Commissioner for Patents
Washington, D.C. 20231

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Sir:

This is a Reply Brief under Rule 193 in response to the Examiner's Answer mailed on October 9, 2002 (Paper No. 21).

It is noted that "[t]he primary examiner must then either:
(A) acknowledge receipt and entry of the reply brief by using
form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution
to respond to the reply brief." M.P.E.P. 1208.03.

Within the Final Office Action, the Examiner provides the Petri reference for the assertion that smart cards would have been known to the skilled artisan at the time the invention was

made. But within the Examiner's Answer, the Examiner now contends that the Petri reference was not relied upon to reject any of the claims, but only to supply support for the Examiner's assertion of what was known in the art (Examiner's Answer at page 10).

But as previously highlighted within the Appeal Brief, the support for the contended use of "Official notice" or the contended "well-known" features deficient within Ishiguro and claims 1-7 of Sugiyama must have existed at the time the claimed invention was made (emphasis added). *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

In this regard, Petri is not prior art to the Applicant's invention. Thus, no support has been provided. Specifically, Petri arguably has a copyright date sometime within the year 1998. However, the above-identified application was filed under 35 U.S.C. §371 and 37 C.F.R. §§1.494 or 1.495 having an International filing date of March 24, 1997 and a priority date of March 24, 1997. See M.P.E.P §201.13(b), 8th Edition, August 2001.

This situation is similar to *Ex parte Natale* wherein the use

of Official notice was challenged for evidentiary support. But in spite of this challenge, the Examiner maintained his position. As a result, the Board of Patent Appeals and Interferences concluded that the Examiner's failure to provide objective evidence to support the challenged officially noticed fact constituted clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989).

All other points have been addressed within the Appeal Brief and the arguments set forth therein are maintained.

The prior art of record fails to disclose, teach or suggest all the features of the claimed invention. For at least the reasons set forth hereinabove, the rejection of the claimed invention should not be sustained. Therefore, a reversal of the Final Rejection of January 17, 2002 is respectfully requested.

Respectfully submitted,



DATE: December 5, 2002

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